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EXAMINER

HUTTON JR, WILLIAM D

ART UNIT PAPER NUMBER

2176

DATE MAILED: 11/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/928,599

Applicant(s)

KOWALSKI, LEE ANNE

Examiner

Doug Hutton

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-66 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-66 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Applicant's Response

In Applicant's Response dated 18 October 2005, Applicant submitted a Request for Continued Examination and requested admission of the after-Final amendment submitted on 20 September 2005. Thus, the after-Final amendment dated 20 September 2005 is admitted into the record.

In the after-Final amendment dated 20 September 2005, Applicant submitted an a declaration under 37 CFR §1.131 to antedate the references used to reject the claims in the Office Action dated 27 July 2005.

131 Declaration

37 CFR 1.131(b) provides three ways in which an applicant can establish prior invention of the claimed subject matter. The showing of facts must be sufficient to show:

- reduction to practice of the invention prior to the effective date of the reference;
or
- conception of the invention prior to the effective date of the reference coupled with due diligence from prior to the reference date to a subsequent (actual) reduction to practice; or
- conception of the invention prior to the effective date of the reference coupled with due diligence from prior to the reference date to the filing date of the application (constructive reduction to practice).

Applicant's declaration fails to specify which particular method upon which Applicant relies to establish prior invention of the claimed subject matter. Regardless of the method relied upon by Applicant, the declaration filed on 20 September 2005 under 37 CFR 1.131 has been considered but is ineffective to overcome the references for the following reasons.

Firstly, Applicant states that the invention was conceived and thereafter diligently reduced to practice "*in this country*" (see Statements 2, 2a and 2c). This statement does not indicate in which country the invention was conceived and thereafter diligently reduced to practice. Applicant may correct this deficiency by amending the statement to declare that the invention was conceived and thereafter diligently reduced to practice in the United States of America.

Secondly, Applicant states that the invention was conceived, as evidenced by the exhibits (see Statement 2a), and that the development of the invention proceeded on a continuous basis from prior to June 21, 2000 and eventually culminated in the filing of the present application on August 13, 2001 (see Statement 2c).

The affidavit or declaration and exhibits must clearly explain which facts or data Applicant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice "amounts essentially to mere pleading, unsupported by proof or a showing of facts" and,

thus, does not satisfy the requirements of 37 CFR 1.131(b). *In re Borkowski*, 505 F.2d 713, 184 USPQ 29 (CCPA 1974). Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by Applicant. 505 F.2d at 718-19, 184 USPQ at 33.

The declaration does not clearly explain which facts or data Applicant is relying on to show completion of her invention prior to June 21, 2000. The declaration comprises vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits demonstrate a reduction to practice. Thus, the declaration amounts to a mere pleading unsupported by proof or a showing of facts.

Applicant may correct this deficiency by giving a clear explanation of the exhibits pointing out exactly what facts are established and relied on by Applicant. Particularly, if Applicant is relying upon conception plus due diligence to antedate the references, then Applicant must show evidence of facts establishing diligence.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-16, 19-38, 41-60 and 63-66 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Padwick, Gordon, **Special Edition Using Microsoft Outlook 2002** (Que Publishing, 1 May 2001), in view of Rand et al., U.S. Patent Application Publication No. US 2004/0080528 A1.

Claim 1:

Padwick discloses a computer-implemented method for identifying and distinguishing words contained within an electronic message (see Chapter 28 – Creating and Using Rules, “*Using the Rules Wizard to Manage Incoming Messages*” Pages 1-16 of 16 – Padwick discloses this limitation in that Outlook includes an “Rules Wizard” tool that allows the user to search emails for a particular term or phrase), comprising the steps of:

- comparing, in a computer, message terms in an electronic message to significant terms stored by the computer in an online registry to identify any of the message terms in the electronic message that match the significant terms stored in the online registry (see Figure 28.7; see Pages 1-11 of 16 – Padwick discloses this limitation in that the “Rules Wizard” tool allows the user to create rules to filter emails based on whether user-specified terms are in the emails. Every rule created is stored on the computer, so that the rules may be subsequently applied to emails. Thus, the user-specified terms are “stored” by an “online registry.”); and

- identifying, in the computer, the matched message terms and indicating their significance to a reader by sending electronic messages that include any matched significant message terms to a folder (see Figure 28.8; see Pages 1-11 of 16 – Padwick discloses this limitation in that the “Rules Wizard” tool allows the user to specify that emails satisfying a rule are moved to a particular folder. By moving emails that include user-specified terms to a particular folder, Padwick “identifies the matched message terms” and “indicates their significance to a reader.”).

Padwick fails to expressly disclose:

- *making*, in the computer, *alterations* to the electronic message to identify the matched message terms and to indicate their significance to a reader.

Rand teaches a computer-implemented method for identifying and distinguishing words contained within an electronic message (see Figures 1 and 3; see Paragraphs 0015 and 0049 – Rand teaches this limitation in that the electronic document display system includes an “Keyword Search” tool that allows the user to search documents for a particular term or phrase), comprising the steps of:

- comparing, in a computer, message terms in an electronic message to significant terms to identify any of the message terms in the electronic message that match the significant terms (see Figure 3; see Paragraph 0049 – Rand teaches this limitation in that the electronic document display system includes a “search”

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function, which generates a list of documents that include user-specified search terms); and

- making, in the computer, alterations to the electronic message to identify the matched message terms and to indicate their significance to a reader (see Paragraph 0049 – Rand teaches this limitation in that the electronic document display system allows the user to click on any of the documents in the list and, upon selection of a listed document by the user, displays the document with the highlighted search term. By highlighting the search terms, Rand “identifies” the matched message terms and “indicates their significance.”),

for the purpose of calling the user’s attention to the search terms and clearly indicating the location of the search terms in the document to the user.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Padwick, to include the step of:

- making, in the computer, alterations to the electronic message to identify the matched message terms and to indicate their significance to a reader,

for the purpose of calling the user’s attention to the search terms and clearly indicating the location of the search terms in the document to the user, as taught in Rand.

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Claim 2:

Padwick discloses the method of Claim 1, wherein the electronic message is an authored electronic message (Padwick discloses this limitation in that the searched emails are “electronic messages” that are “authored” by the computer user who wrote them).

Claim 3:

Padwick discloses the method of Claim 1, wherein the electronic message is received electronic message (Padwick discloses this limitation in that the searched emails are “electronic messages” that are “received” by the computer user to whom they were addressed).

Claim 4:

Padwick discloses the method of Claim 1, wherein the significant terms are determined based upon a reader profile (see Chapter 28 – Creating and Using Rules; “*Using the Rules Wizard to Manage Incoming Messages*” and “*Creating Rules for Outgoing Messages*” – Padwick discloses this limitation in that Outlook includes a “Rules Wizard” that allows the user to create rules for processing incoming emails for the “reader”; these rules comprise the “reader profile” that determines the “significant terms”).

Claim 5:

Padwick discloses the method of Claim 1, wherein the significant terms are determined based upon a author profile (Padwick discloses this limitation in that Outlook includes a "Rules Wizard" that allows the user to create rules for processing outgoing emails for the "author"; these rules comprise the "author profile" that determines the "significant terms").

Claim 6:

Padwick, in view of Rand, fails to expressly disclose:

- matched message terms that are identified based upon a reader profile.

However, selecting a particular color or font for display of the located search terms was a design choice that was well-known by one of ordinary skill in the art at the time the invention was made. Rand expressly taught "highlighting" the located search terms, but did not disclose the particular color in which the term is highlighted and whether the color and/or font could be changed by the user. Changing the font and/or color of text in an electronic document was well-known at the time the invention was made by even ordinary computer users. At the time the invention was made, those of ordinary skill in the art – computer programmers – would have known how to design a search tool so a user could select the particular color and/or font in which the located search term was displayed for the purpose of aesthetics.

Additionally, Padwick disclosed a Rules Wizard that allowed the user to compose multiple processing rules that are applied to each received email. Thus, two rules could

have been written to locate two different search requests for received emails and display each located term in different colors and/or fonts for the purpose of distinguishing the different search requests within each email. The different located terms displayed in different colors and/or fonts would have constituted "matched significant message terms" that are identified base upon a "reader profile."

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Padwick, in view of Rand, to include matched message terms that are identified based upon a reader profile for the purposes of aesthetics and distinguishing the different search requests within each email.

Claim 7:

Padwick, in view of Rand, fails to expressly disclose:

- matched message terms that are identified based upon an author profile.

However, selecting a particular color or font for display of the located search terms was a design choice that was well-known by one of ordinary skill in the art at the time the invention was made. Rand expressly taught "highlighting" the located search terms, but did not disclose the particular color in which the term is highlighted and whether the color and/or font could be changed by the user. Changing the font and/or color of text in an electronic document was well-known at the time the invention was made by even ordinary computer users. At the time the invention was made, those of ordinary skill in the art – computer programmers – would have known how to design a search tool so a

user could select the particular color and/or font in which the located search term was displayed for the purpose of aesthetics.

Additionally, Padwick disclosed a Rules Wizard that allowed the user to compose multiple processing rules that are applied to each sent email. Thus, two rules could have been written to locate two different search requests for sent emails and display each located term in different colors and/or fonts for the purpose of distinguishing the different search requests within each email. The different located terms displayed in different colors and/or fonts would have constituted "matched message terms" that are identified base upon an "author profile."

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Padwick, in view of Rand, to include matched message terms that are identified based upon a author profile for the purposes of aesthetics and distinguishing the different search requests within each email.

Claim 8:

Padwick discloses the method of Claim 1, further comprising the step of collecting and storing significant terms in the online registry (see Chapter 28 – Creating and Using Rule; *"Using the Rules Wizard to Manage Incoming Messages"* and *"Creating Rules for Outgoing Messages"* – Padwick discloses this limitation in that Outlook includes a "Rules Wizard" that allows the user to create and save rules for

searching incoming or outgoing emails for particular terms; thus, the rules constitute an “online registry” of “significant terms”).

Claim 9:

Padwick discloses the method of Claim 1, wherein the step of collecting and storing comprises a user selecting significant terms (Padwick discloses this limitation in that Outlook includes a “Rules Wizard” that allows the user to create and save rules for searching incoming or outgoing emails for particular terms; thus, the user “selects significant terms”).

Claim 10:

Padwick discloses the method of Claim 8, wherein the step of collecting and storing comprises importing significant terms (see Chapter 28 – Creating and Using Rule; “*Managing Rules*” – Padwick discloses this limitation in that a set of rules, for searching incoming or outgoing emails for particular terms, can be imported from a file).

Claim 11:

Padwick discloses the method of Claim 10, wherein significant terms are imported from an address book (Padwick discloses this limitation in that a set of rules, for searching incoming or outgoing emails for particular terms, can be imported from a file; a “file” includes an address book).

Claim 12:

Padwick discloses the method of Claim 10, wherein significant terms are imported from a database (Padwick discloses this limitation in that a set of rules, for searching incoming or outgoing emails for particular terms, can be imported from a file; a "file" includes a database).

Claim 13:

Padwick discloses the method of Claim 1, wherein the significant terms comprise names of people, product terms or key words in a user's field (Padwick discloses this limitation in that the Rules Wizard allows the user to select the search terms, which may include "names of people"; for example, see Figure 28.4).

Claims 14-16:

Padwick, in view of Rand, fails to expressly disclose:

- making alterations to the electronic message comprises making the matched message terms a different color, a different font effect, or a different font type.

However, selecting a particular color, font effect, or font type for displaying the located search terms was a design choice that was well-known by one of ordinary skill in the art at the time the invention was made. Rand expressly taught "highlighting" the located search terms, but did not disclose the particular color in which the term is highlighted and whether the color, font effect, and/or font type could be changed by the user.

Changing the font effect, font type, and/or color of text in an electronic document was

well-known at the time the invention was made by even ordinary computer users. At the time the invention was made, those of ordinary skill in the art – computer programmers – would have known how to design a search tool so a user could select the particular color, font effect, and/or font type in which the located search term was displayed for the purpose of aesthetics.

Additionally, Padwick disclosed a Rules Wizard that allowed the user to compose multiple processing rules that are applied to each sent email. Thus, two rules could have been written to locate two different search requests for sent emails and display each located term in different colors, font effects, and/or font types, for the purpose of distinguishing the different search requests within each email.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Padwick, in view of Rand, to include making alterations to the electronic message comprises making the matched message terms a different color, a different font effect, or a different font type, for the purposes of aesthetics and distinguishing the different search requests within each email.

Claim 19:

Padwick discloses the method of Claim 1, wherein identifying where the alterations to the matched message terms, taught by Rand, are to be performed according to a user setting (Padwick discloses this limitation in that the Rules Wizard

allows the user to select the search terms; thus, making the search term "distinct" is performed "according to a user setting").

Claim 20:

Padwick discloses the method of Claim 19, wherein the significant terms are categorized and the user setting is based upon a category of the significant term (Padwick discloses this limitation in that the Rules Wizard allows the user to select the search terms and process email messages containing each different search term in a particular way; for example, Outlook can search for all emails that include the term "deadline" and send those emails to a certain folder, or Outlook can search for all emails that include the term "office party" and delete those emails; thus, the significant terms are "categorized" and the user setting processes emails having the significant terms "based on a category of the significant term").

Claim 21:

Padwick fails to expressly disclose displaying the electronic message if the end of the electronic messages as been reached.

Rand teaches a method for identifying and distinguishing words contained within an electronic message (see Figures 1 and 3; see Paragraphs 0015 and 0049 – Rand teaches this limitation in that the electronic document display system includes an "Keyword Search" tool that allows the user to search documents for a particular term or phrase), comprising the step of:

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- displaying the electronic message if the end of the electronic messages as been reached (see Paragraph 0049 – Rand teaches this limitation in that the electronic document display system allows the user to click on any of the documents in the list and, upon selection of a listed document by the user, displays the document with the highlighted search term; thus, the electronic document processing system has scanned the document for the significant term and displays the document “if the end of the electronic messages as been reached”),

for the purpose of indicating the location of the search terms in the document to the user.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Padwick, to include the step of displaying the electronic message if the end of the electronic messages as been reached for the purpose of indicating the location of the search terms in the document to the user, as taught in Rand.

Claim 22:

Padwick fails to expressly disclose querying a user before making alterations to the electronic message.

Rand teaches a method for identifying and distinguishing words contained within an electronic message (see Figures 1 and 3; see Paragraphs 0015 and 0049 – Rand teaches this limitation in that the electronic document display system includes an

“Keyword Search” tool that allows the user to search documents for a particular term or phrase), comprising the step of:

- querying a user before making alterations to the electronic message (see Figures 1 and 3; see Paragraphs 0015 and 0049 – Rand teaches this limitation in that the electronic document display system allows the user to search the document for particular terms and distinctly displays those terms; thus, the electronic document processing system “queries the user before making alterations to the electronic message”),

for the purpose of indicating the location of the search terms in the document to the user.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Padwick, to include the step of querying a user before making alterations to the electronic message, for the purpose of indicating the location of the search terms in the document to the user, as taught in Rand.

Claims 23-38 and 41-44:

These claims merely recite an apparatus for performing the method of Claims 1-16 and 19-22. Padwick discloses an “electronic message processor” (Claim 23, Line 3) and Rand teaches an “electronic message editor” (Claim 23, Line 6).

Thus, Claims 23-38 and 41-44 are rejected using the same rationale used in the above rejections for Claims 1-16 and 19-22, respectively.

Claims 45-60 and 63-66:

These claims merely recite computer software for performing the method of Claims 1-16 and 19-22. Both Padwick and Rand operate via computer software.

Thus, Claims 45-60 and 63-66 are rejected using the same rationale used in the above rejections for Claims 1-16 and 19-22, respectively.

Claims 17 and 18 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Padwick, in view of Rand, and further in view of Abu-Hakima et al., U.S. Patent Application Publication No. US 2003/0020749 A1.

Claim 17:

As indicated in the above discussion, Padwick, in view of Rand, discloses/teaches every limitation of Claim 1.

Padwick, in view of Rand, fails to expressly disclose:

- inserting an object into the electronic message near the matched message term.

Abu-Hakima teaches a method for identifying and distinguishing words contained within an electronic message (see Paragraphs 0001 and 0006-0008 – Abu-Hakima

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teaches this limitation in that the electronic document processor searches for concepts and displays those concepts), comprising the steps of:

- inserting an object into the electronic message near the matched message term (see Figure 4; see Paragraph 0067 – Abu-Hakima teaches this limitation in that the electronic document processor displays the concept within an icon), for the purpose of calling the user's attention to the message in which the matched significant message term is located.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Padwick, in view of Rand, to include inserting an object into the electronic message near the matched message term, for the purpose of calling the user's attention to the message in which the matched significant message term is located, as taught by Abu-Hakima.

Claim 18:

Padwick, in view of Rand, fails to expressly disclose:

- an object that comprises an image, a sound file, an icon, a link or a video.

Abu-Hakima teaches a method for identifying and distinguishing words contained within an electronic message (see Paragraphs 0001 and 0006-0008 – Abu-Hakima

teaches this limitation in that the electronic document processor searches for concepts and displays those concepts), comprising the steps of:

- selecting an object that comprises an image, a sound file, an icon, a link or a video (see Figure 4; see Paragraph 0067 – Abu-Hakima teaches this limitation in that the electronic document processor displays the concept within an icon), for the purpose of calling the user's attention to the message in which the matched significant message term is located.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Padwick, in view of Rand, to include selecting an object from the group consisting of an image, a sound file, an icon, a link and a video for the purpose of calling the user's attention to the message in which the matched significant message term is located, as taught by Abu-Hakima.

Claims 39 and 40:

These claims merely recite an apparatus for performing the method of Claims 17 and 18. Padwick discloses an "electronic message processor" (Claim 23, Line 3) and Rand teaches an "electronic message editor" (Claim 23, Line 6).

Thus, Claims 39 and 40 are rejected using the same rationale used in the above rejections for Claims 17 and 18, respectively.

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Claims 61 and 62:

These claims merely recite computer software for performing the method of Claims 17 and 18. Both Padwick and Rand operate via computer software.

Thus, Claims 61 and 62 are rejected using the same rationale used in the above rejections for Claims 17 and 18, respectively.

Claims 1-16, 19-38, 41-60 and 63-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Padwick, et al., **Special Edition Using Microsoft Outlook 2000** (Que Publishing, 12 May 1999), in view of Chen et al., U.S. Patent No. 6,009,442.

Claim 1:

Padwick discloses a *computer-implemented method for identifying and distinguishing words contained within an electronic message* (see Chapter 22 – Creating and Using Rules, “*Using the Rules Wizard to Create Rules that Manage Incoming Messages*” Pages 1-19 of 19 – Padwick discloses this limitation in that Outlook includes an “Rules Wizard” tool that allows the user to search emails for a particular term or phrase), *comprising the steps of:*

- *comparing, in a computer, message terms in an electronic message to significant terms stored by the computer in an online registry to identify any of the message terms in the electronic message that match the significant terms stored in the online registry* (see Pages 1-19 of 19 – Padwick discloses this limitation in that the “Rules Wizard” tool allows the user to create rules to filter emails based on

whether user-specified terms are in the emails. Every rule created is stored on the computer, so that the rules may be subsequently applied to emails. Thus, the user-specified terms are "stored" by an "online registry."); *and*

- *identifying, in the computer, the matched message terms and indicating their significance to a reader by sending electronic messages that include any matched significant message terms to a folder* (see Pages 1-19 of 19 – Padwick discloses this limitation in that the "Rules Wizard" tool allows the user to specify that emails satisfying a rule are moved to a particular folder. By moving emails that include user-specified terms to a particular folder, Padwick "identifies the matched message terms" and "indicates their significance to a reader.").

Padwick fails to expressly disclose:

- ***making**, in the computer, **alterations** to the electronic message to identify the matched message terms and to indicate their significance to a reader.*

Chen teaches *a computer-implemented method for identifying and distinguishing words contained within an electronic message* (see Figures 1-22; see Column 1, Line 1 through Column 22, Line 43 – Chen teaches this limitation in that the computer-based document management system allows a user to define criteria comprising key terms, wherein the system identifies documents - including email messages - that satisfy the user-specified criteria and, when displaying those documents to the user, highlights the key terms), *comprising the step of:*

- *making, in the computer, alterations to the electronic message to identify the matched message terms and to indicate their significance to a reader* (see Figures 1-22; see Column 1, Line 1 through Column 22, Line 43 – Chen teaches this limitation in that the computer-based document management system allows a user to define criteria comprising key terms, wherein the system identifies documents - including email messages - that satisfy the user-specified criteria and, when displaying those documents to the user, highlights the key terms. By highlighting the key terms, Chen “identifies matched message terms” and “indicates their significance to a reader.”),

for the purpose of calling the user’s attention to the portion(s) of the displayed document that contain the key terms.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Padwick, to include the step of:

- *making, in the computer, alterations to the electronic message to identify the matched message terms and to indicate their significance to a reader,*

for the purpose of calling the user’s attention to the portion(s) of the displayed document that contain the key terms, as taught in Chen.

Claim 2:

Padwick discloses an *electronic message [that] is an authored electronic message* (Padwick discloses this limitation in that the searched emails are “electronic messages” that are “authored” by the computer user who wrote them).

Claim 3:

Padwick discloses an *electronic message [that] is a received electronic message* (Padwick discloses this limitation in that the searched emails are “electronic messages” that are “received” by the computer user to whom they were addressed).

Claim 4:

Padwick discloses *significant terms [that] are determined based upon a reader profile* (see Chapter 22 – Creating and Using Rules; “*Using the Rules Wizard to Create Rules that Manage Incoming Messages*” Pages 1-19 of 19 and “*Creating Rules for Outgoing Messages*” Pages 1-2 of 2 – Padwick discloses this limitation in that Outlook includes a “Rules Wizard” that allows the user to manually create rules for processing incoming emails for the “reader.” These rules comprise the “reader profile” that determines the “significant terms.”).

Claim 5:

Padwick discloses *significant terms [that] are determined based upon a author profile* (Padwick discloses this limitation in that Outlook includes a “Rules Wizard” that

allows the user to create rules for processing outgoing emails for the "author"; these rules comprise the "author profile" that determines the "significant terms").

Claim 6:

Padwick, in view of Chen, fails to expressly disclose:

- *matched message terms [that] are identified based upon a reader profile.*

However, selecting a particular color or font for display of the located search terms was a design choice that was well-known by one of ordinary skill in the art at the time the invention was made. Chen expressly taught "highlighting" the located search terms, but did not disclose the particular color in which the term is highlighted and whether the color and/or font could be changed by the user. Changing the font and/or color of text in an electronic document was well-known at the time the invention was made by ordinary computer users. At the time the invention was made, those of ordinary skill in the art (e.g., computer programmers) would have known how to design a search tool so a user could select the particular color and/or font in which the located search term was displayed for the purpose of aesthetics.

Additionally, Padwick disclosed a Rules Wizard that allowed the user to compose multiple processing rules that are applied to each received email. Thus, two rules could have been written to locate two different search requests for received emails and display each located term in different colors and/or fonts for the purpose of distinguishing the different search requests within each email. The different located

terms displayed in different colors and/or fonts would have constituted “matched significant message terms” that are identified base upon a “reader profile.”

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Padwick, in view of Chen, to include matched message terms that are identified based upon a reader profile for the purposes of facilitating aesthetics and distinguishing the different search requests within each email.

Claim 7:

Padwick, in view of Chen, fails to expressly disclose:

- *matched message terms [that] are identified based upon an author profile.*

However, selecting a particular color or font for display of the located search terms was a design choice that was well-known by one of ordinary skill in the art at the time the invention was made. Chen expressly taught “highlighting” the located search terms, but did not disclose the particular color in which the term is highlighted and whether the color and/or font could be changed by the user. Changing the font and/or color of text in an electronic document was well-known at the time the invention was made by even ordinary computer users. At the time the invention was made, those of ordinary skill in the art (e.g., computer programmers) would have known how to design a search tool so a user could select the particular color and/or font in which the located search term was displayed for the purpose of aesthetics.

Additionally, Padwick disclosed a Rules Wizard that allowed the user to compose multiple processing rules that are applied to each sent email. Thus, two rules could have been written to locate two different search requests for sent emails and display each located term in different colors and/or fonts for the purpose of distinguishing the different search requests within each email. The different located terms displayed in different colors and/or fonts would have constituted "matched message terms" that are identified base upon an "author profile."

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Padwick, in view of Chen, to include matched message terms that are identified based upon a author profile for the purposes of aesthetics and distinguishing the different search requests within each email.

Claim 8:

Padwick discloses *the step of collecting and storing significant terms in the online registry* (see Chapter 22 – Creating and Using Rules; "*Using the Rules Wizard to Create Rules that Manage Incoming Messages*" Pages 1-19 of 19 and "*Creating Rules for Outgoing Messages*" Pages 1-2 of 2 – Padwick discloses this limitation in that Outlook includes a "Rules Wizard" that allows the user to create and save rules for searching incoming or outgoing emails for particular terms. Thus, the rules constitute an "online registry" of "significant terms.>").

Claim 9:

Padwick discloses a *step of collecting and storing [that] comprises a user selecting significant terms* (Padwick discloses this limitation in that Outlook includes a "Rules Wizard" that allows the user to create and save rules for searching incoming or outgoing emails for particular terms; thus, the user "selects significant terms").

Claim 10:

Padwick discloses a *step of collecting and storing [that] comprises importing significant terms* (see Chapter 28 – Creating and Using Rule; "Managing Rules" – Padwick discloses this limitation in that a set of rules, for searching incoming or outgoing emails for particular terms, can be imported from a file).

Claim 11:

Padwick discloses *significant terms [that] are imported from an address book* (Padwick discloses this limitation in that a set of rules, for searching incoming or outgoing emails for particular terms, can be imported from a file; a "file" includes an address book).

Claim 12:

Padwick discloses *significant terms [that] are imported from a database* (Padwick discloses this limitation in that a set of rules, for searching incoming or outgoing emails for particular terms, can be imported from a file; a "file" includes a database).

Claim 13:

Padwick discloses *significant terms [that] comprise names of people, product terms or key words in a user's field* (Padwick discloses this limitation in that the Rules Wizard allows the user to select the search terms, which may include "names of people"; for example, see Figure 28.4).

Claims 14-16:

Padwick, in view of Chen, fails to expressly disclose:

- *making alterations to the electronic message comprises making the matched message terms a different color, a different font effect, or a different font type.*

However, selecting a particular color, font effect, or font type for displaying the located search terms was a design choice that was well-known by one of ordinary skill in the art at the time the invention was made. Chen expressly taught "highlighting" the located search terms, but did not disclose the particular color in which the term is highlighted and whether the color, font effect, and/or font type could be changed by the user.

Changing the font effect, font type, and/or color of text in an electronic document was well-known at the time the invention was made by even ordinary computer users. At the time the invention was made, those of ordinary skill in the art (e.g., computer programmers) would have known how to design a search tool so a user could select the particular color, font effect, and/or font type in which the located search term was displayed for the purpose of facilitating aesthetics.

Additionally, Padwick disclosed a Rules Wizard that allowed the user to compose multiple processing rules that are applied to each sent email. Thus, two rules could have been written to locate two different search requests for sent emails and display each located term in different colors, font effects, and/or font types, for the purpose of distinguishing the different search requests within each email.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Padwick, in view of Chen, to include making alterations to the electronic message comprises making the matched message terms a different color, a different font effect, or a different font type, for the purposes of aesthetics and distinguishing the different search requests within each email.

Claim 19:

Padwick discloses *identifying where the alterations to the matched message terms*, taught by Rand, *[is to be] performed according to a user setting* (Padwick discloses this limitation in that the Rules Wizard allows the user to select the search terms; thus, making the search term “distinct” is performed “according to a user setting”).

Claim 20:

Padwick discloses *significant terms [that] are categorized and the user setting is based upon a category of the significant term* (Padwick discloses this limitation in that

the Rules Wizard allows the user to select the search terms and process email messages containing each different search term in a particular way. For example, Outlook can search for all emails that include the term "deadline" and send those emails to a certain folder, or Outlook can search for all emails that include the term "office party" and delete those emails. Thus, the significant terms are "categorized" and the user setting processes emails having the significant terms "based on a category of the significant term.").

Claim 21:

Padwick fails to expressly disclose displaying the electronic message if the end of the electronic messages as been reached.

Chen teaches *a method for identifying and distinguishing words contained within an electronic message* (see Figures 1-22; see Column 1, Line 1 through Column 22, Line 43 – Chen teaches this limitation in that the computer-based document management system allows a user to define criteria comprising key terms, wherein the system identifies documents - including email messages - that satisfy the user-specified criteria and, when displaying those documents to the user, highlights the key terms), *comprising the step of:*

- *displaying the electronic message if the end of the electronic messages as been reached* (see Figures 1-22; see Column 1, Line 1 through Column 22, Line 43 – Chen teaches this limitation in that the computer-based document management

system allows the user to click on any document in a list of documents meeting the user-specified criteria and, upon selection of one of the listed documents by the user, displays the document with the highlighted search term. Thus, the system has scanned the document for the significant term and displays the document "if the end of the electronic messages as been reached."), for the purpose of calling the user's attention to the portion(s) of the displayed document that contain the key terms.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Padwick, to include the *step of displaying the electronic message if the end of the electronic messages as been reached* for the purpose of calling the user's attention to the portion(s) of the displayed document that contain the key terms, as taught in Chen.

Claim 22:

Padwick fails to expressly disclose querying a user before making alterations to the electronic message.

Chen teaches a *method for identifying and distinguishing words contained within an electronic message* (see Figures 1-22; see Column 1, Line 1 through Column 22, Line 43 – Chen teaches this limitation in that the computer-based document

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management system allows a user to define criteria comprising key terms, wherein the system identifies documents - including email messages - that satisfy the user-specified criteria and, when displaying those documents to the user, highlights the key terms), *comprising the step of:*

- *querying a user before making alterations to the electronic message* (see Figures 1-22; see Column 1, Line 1 through Column 22, Line 43 – Chen teaches this limitation in that the computer-based document management system allows the user to search documents for particular terms and distinctly displays those terms when one of the documents meeting the user-specified criteria is displayed.

Thus, the system “queries the user before making alterations to the electronic message.”),

for the purpose of calling the user’s attention to the portion(s) of the displayed document that contain the key terms.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Padwick, to include the *step of querying a user before making alterations to the electronic message*, for the purpose of calling the user’s attention to the portion(s) of the displayed document that contain the key terms, as taught in Chen.

Claims 23-38 and 41-44:

These claims merely recite an apparatus for performing the method of Claims 1-16 and 19-22. Padwick discloses and Chen teaches computer systems.

Thus, Claims 23-38 and 41-44 are rejected using the same rationale used in the above rejections for Claims 1-16 and 19-22, respectively.

Claims 45-60 and 63-66:

These claims merely recite computer software for performing the method of Claims 1-16 and 19-22. Both Padwick and Chen operate via computer software.

Thus, Claims 45-60 and 63-66 are rejected using the same rationale used in the above rejections for Claims 1-16 and 19-22, respectively.

Claims 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Padwick, in view of Chen, and further in view of Larson et al., U.S. Patent No. 5,825,854.

Claim 17:

As indicated in the above discussion, Padwick, in view of Chen, discloses/teaches every limitation of Claim 1.

Padwick, in view of Chen, fails to expressly disclose:

- *inserting an object into the electronic message near the matched message term.*

Larson teaches a *method for identifying and distinguishing words contained within an electronic message* (see Figures 1-10; see Column 1, Line 1 through Column 18, Line 42 – Larson teaches this limitation in that the telephone access system to audibly highlight a word that is graphically highlighted in an electronic message), *comprising the steps of:*

- *inserting an object into the electronic message near the highlighted message term* (see Figures 1-10; see Column 1, Line 1 through Column 18, Line 42 – Larson teaches this limitation in that the telephone access system inserts an audio file at a highlighted term in an electronic message),
for the purpose of audibly notifying a user of highlighted text within an electronic message when the user accesses the message via a telephone.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Padwick, in view of Chen, to include *inserting an object into the electronic message near the matched message term*, for the purpose of audibly notifying a user of highlighted text within an electronic message when the user accesses the message via a telephone, as taught by Larson.

Claim 18:

Padwick, in view of Rand, fails to expressly disclose:

- *an object that comprises an image, a sound file, an icon, a link or a video.*

Larson teaches *a method for identifying and distinguishing words contained within an electronic message* (see Figures 1-10; see Column 1, Line 1 through Column 18, Line 42 – Larson teaches this limitation in that the telephone access system to audibly highlight a word that is graphically highlighted in an electronic message), *comprising the steps of:*

- *selecting an object that comprises an image, a sound file, an icon, a link or a video* (see Figures 1-10; see Column 1, Line 1 through Column 18, Line 42 – Larson teaches this limitation in that the telephone access system inserts an audio file at a highlighted term in an electronic message),

for the purpose of audibly notifying a user of highlighted text within an electronic message when the user accesses the message via a telephone.

Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method, disclosed in Padwick, in view of Chen, to include *selecting an object from the group consisting of an image, a sound file, an icon, a link and a video*, for the purpose of audibly notifying a user of highlighted text within an electronic message when the user accesses the message via a telephone, as taught by Larson.

Claims 39 and 40:

These claims merely recite an apparatus for performing the method of Claims 17 and 18. Padwick discloses and both Chen and Larson teach computer systems. .

Thus, Claims 39 and 40 are rejected using the same rationale used in the above rejections for Claims 17 and 18, respectively.

Claims 61 and 62:

These claims merely recite computer software for performing the method of Claims 17 and 18. Both Padwick, Chen and Larson operate via computer software.

Thus, Claims 61 and 62 are rejected using the same rationale used in the above rejections for Claims 17 and 18, respectively.

Response to Arguments

Applicant did not submit arguments in support of the claims in the responses dated 20 September 2005 and 18 October 2005.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Doug Hutton whose telephone number is (571) 272-4137. The examiner can normally be reached on Monday-Friday from 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached at (571) 272-4136. The fax phone

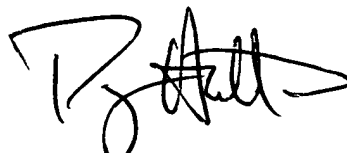
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number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

WDH

November 22, 2005

A handwritten signature in black ink, appearing to read 'D. Hutton', with a stylized flourish at the end.

**DOUG HUTTON
PATENT EXAMINER
TECH CENTER 2100**